IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of	:	BERNSTEIN, Joel E.
Serial No.	:	10/772,809
Filed	:	February 5, 2004
For	:	METHOD AND COMPOSITIONS FOR TREATMENT OF PAINFUL DISORDERS
Examiner	:	CLAYTOR, Deirdre Renee
Art Unit	:	1627
Customer number	:	23644
Confirmation No.	:	5946
Attorney Docket No.	:	41958-102748

APPEAL BRIEF

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This appeal is from the Examiner's Office Action mailed August 21, 2009, in which pending claims (namely, claims 9, 11, 12, 14, 15 and 17), were finally rejected and the Advisory Action mailed January 21, 2010. A timely Notice of Appeal was filed with the required fee on January 21, 2010.

This brief is being filed along with the required $270 fee pursuant to 37 C.F.R. §41.20(b)(2) that should be deducted from Deposit Account No. 12-0913.

A fee for a one month extension of time until May 21, 2010 is enclosed.

(i) Real Party of Interest

The Real Party of Interest is RODLEN LABORATORIES, INC. The Assignment is recorded at Reel 014970, Frame 0004.

(ii) Related Appeals and Interferences

Appellant is not aware of any related appeals or interferences.

(iii) Status of Claims

Claims 1-8 were withdrawn but prepared for rejoinder.

Claims 10, 13 and 16 are cancelled.

Claims 9, 11, 12, 14, 15 and 17 are pending.

(iv) Status of Amendments

A restriction requirement was issued. Group II was elected but claim 1 of Group I was made dependent on claim 9 of Group II for possible rejoinder. Claims 9, 10 and 14 were amended October 27, 2005.

In the Summary of the Interview of January 30, 2007, claim 10 was amended to recite a daily dose, the dose in claim 13 was amended, and new claims 16 and 17 were added with doses.

On November 7, 2007, claim 9 was amended to relate administration of a single pharmaceutical vehicle or separate preparations taken one after the other. Claim 9 was amended April 28, 2009 to remove the option of 2 separate administrations. Exact doses were removed from claim 11.

2 RCE's have been filed.

A Final Rejection issued August 21, 2009, the response filed November 23, 2009 was not entered. An Advisory Action was mailed January 2, 2010.

(v) Summary of Claimed Subject Matter

A composition for treatment of chronic pain consisting essentially of a combination of a low dose of a tricyclic antidepressant compound, said dose in the range 2.5-25 mg [0008] and a standard dose of a non-narcotic analgesic [0009] in a single pharmaceutically acceptable vehicle for oral administration.

The tricyclic antidepressant compound is selected from the group of tricyclic compounds consisting of amitriptyline, desipramine, imipramine, and physiologically acceptable acid addition salts thereof. [00011]

Physiologically acceptable acid addition salts are selected from the group consisting of the hydrochloride, hydrobromide, hydroiodide, acetate, valerate and oleate. [00011]

A non-narcotic analgesic is selected from the group consisting of acetaminophen and non-steroidal anti-inflammatory drugs. [00010]

The combination of a tricyclic antidepressant and a non-narcotic analgesic and a pharmaceutically acceptable vehicle is in a form selected from the group consisting of tablets, capsules, caplets, oral solutions and oral suspensions. [00012]

The non-narcotic analgesic is administered in a dosage of from about 0.5 gm to about 2.6 gm daily. [00010]

Unexpectedly dramatic amelioration of pain in patients with chronic painful neuropathic or fibromuscular disorders result from treatment with the claimed composition, and with rare side effects. [0005] [0006]

(vi) Grounds of Rejection To Be Reviewed on Appeal

There are 2 rejections on appeal:

Claims 9, 11, 14-15 are rejected under 35 USC §102 over Crawford.

Claims 12 and 17 are rejected under 35 USC §103 over Crawford, Matheson and Carusso.

(vii) Argument

I. Crawford Does Not Anticipate Claims 9, 11, 14-15 Because The Publication Does Not Teach All Claim Elements

Crawford teaches an anti-inflammatory composition. Piroxicam is essential. Analgesics listed in the composition are acetaminophen, antidepressant doxepin, bronchodilator pirubuterol, minor tranquilizer diazepam, or anithypertensive agent

trimoyosin. Crawford's goal was an improved anti-inflammatory composition that reduced gastrointestinal (GI) irritation. Large amounts of ingredients are in his teachings as optionally in a composition - these are not within the scope of "consisting essentially of" of the present invention, which does not include all these compounds, and whose goal is pain relief, not to reduce GI irritation. "Consisting essentially of" should include materials specified in the claim "and those that do not materially affect the basic and novel characteristics of the claimed invention." (see MPEP 2111.03). Applicant believes this definition excludes the piroxicam, and analgesics of Crawford. Those of skill in the art would **not** consider teachings of Crawford when searching for a pain relief medication because no data is presented in Crawford regarding pain or pain relief.

"Consisting Essentially Of" - Defined as: Materials specified in the claims "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *Quotation from In re Herz*, 537 F.2d 549, 551-52 (CCPA 1976) *as cited in* MPEP 2111.03. The combinations of Crawford would affect the basic and novel characteristics of the claimed invention, so would not be within the scope of the present claims.

The examiner discounted applicant's argument that the present composition is directed toward pain relief. Whereas the examiner agrees, Crawford's goal is to reduce GI irritation, he discounted the preamble as not having patentable weight.

Applicant's argument is not just that a preamble should be accounted patentable weight, but that those of skill in the art seeking a pain relief composition, would not be directed to Crawford who does not even mention pain. This publication would not appear in a "pain" literature search.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir.

1999). The stated goal of the disclosure is pain relief so the preamble fulfills the criteria in the court decision.

Although claims at issue are to a composition not a method, all case law indicates the preamble relates to the claim interpretation.

See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003) (In a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia.); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1346-48, 64 USPQ2d 1202, 1204-05 (Fed. Cir. 2002) (A claim at issue was directed to a method of preparing a food rich in glucosinolates wherein cruciferous sprouts are harvested prior to the 2-leaf stage. The court held that the preamble phrase "rich in glucosinolates" helps define the claimed invention, as evidenced by the specification and prosecution history, and thus is a limitation of the claim (although the claim was anticipated by prior art that produced sprouts inherently "rich in glucosinolates")).

Also, because of the large number of analgesics listed with piroxicam, there is no guidance to the present claimed composition.

Dose range of the tricyclic anti-depressant of claim 9 is not in Crawford, nor does the Examiner allege teaching the claimed dose range. The examiner admits that Crawford et al. teaches piroxicom with doxepin, although separately administered and that "Crawford et al. does not specifically teach that the compositions as exemplified comprise a standard dose and a low dose" in the Office Action mailed January 28, 2009, at p. 16. Therefore, at least one claimed element is not taught in Crawford so it cannot anticipate.

II. A Prima Facie Case of Obviousness Is Not Established.

Claims 12 and 17 were rejected over Crawford, with Caruso and with Matheson.

An improvement of the lower tricyclic antidepressant doses claimed herein is to eliminate side effects, notably sedation and anticholinergic side effects such as dry mouth, blurred vision and urinary retention.

Caruso teaches only an antidepressant, the invention presented to those of skill in the art is

> effectiveness of an antidepressant is significantly potentiated by administering the antidepressant prior to, with or following the administration of a nontoxic NMDA receptor antagonist.

for alleviation of "neuropathic pain." (Caruso, Abstract and p. 1). To alleviate this level of pain, much higher doses than claimed herein, are necessary.

Unless "a nontoxic NMDA receptor antagonist" as defined on p.1, lines 19-24, is the same as a "non-narcotic analgesic" in present claim 9 from which claim 17 depends, Caruso's contribution to an obviousness rejection is at most providing an "antidepressant." Examples of non-narcotic analgesics in the present application are acetaminophen and NSAIDs (e.g., aspirin, ibuprofen, flurbiprofen, ketoprofen, and naproxen).

It would be clear to those of skill in the art that what Caruso **teaches is** a composition of

- antidepressant plus
- non-toxic NMDA receptor antagonist.

The entire thrust of the invention is these two components, as set forth in claim 9 as amended. The teaching is that in combination they improve pain relief. The entire Summary, and the first three pages of the Description of the Preferred Embodiments must be read until page 7, lines 10-24 referred to by the Examiner, in which a laundry list of "optionally" included "pharmacologically active substances" appears – over 50 (fifty) of such substances are listed. In the laundry list there is a category "non-narcotic analgesics" – the second component of the two part composition of the present claims, but there is no guidance to select one of the multiple optional categories, nor any discussion of what they would add to the effects of Caruso's invention that would teach one of skill in the art to make a composition

including an **optional** component of Caruso's composition and **excluding** an **essential** compound.

Doses (325 mg) of some non-narcotic analgesics are only provided for these optional ingredients within a table format called "Examples 1-46". These must be in combination with not only an antidepressant, but also a non-toxic NMDA receptor antagonist. This is not teaching the present claims. One of skill in the art would not be led to tease out of a laundry list, the combination presently claimed. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species).

Matheson does not substitute for deficiencies in Crawford with Caruso. Matheson only described rofecoxib. Matheson and Figgitt is simply a review of Rafecoxib, a (COX)-2 inhibitor. It really stretches the imagination to postulate how those of skill would combine this publication with Crawford, and in doing so come up with the claimed invention. A determination of obviousness requires that "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *KSR International Co. v. Teleflex, Inc.*, -- U.S. --, 127 S.Ct. 1727, 1734, 82 U.S.P.Q.2d 1385 (2007) *quoting Graham v. John Deer Co.*, 383 U.S. 1, 17 (1966). In making a determination of obviousness by looking at the teachings of multiple patents, one should consider

> the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be **made explicit**.

KSR, 127 S.Ct. at 1740-41 (*emphasis added*). "[A] patent composed of several elements is not proved obvious merely by demonstrating the each of its elements was, independently, known in the prior art." *Id.* at 1741. Since this is all the examiner has done in the present case, please withdraw this rejection.

Reversal of the Examiner is therefore clearly in order and is solicited.

Respectfully submitted,

Date: May 21, 2010

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Claims Appendix

1. (Withdrawn) A method for treatment of chronic pain comprising orally administering the composition of claim 9.

2. (Withdrawn) The method of claim 1 wherein said tricyclic antidepressant is administered in a dosage of from about 2.5 mg to about 25 mg daily.

3. (Withdrawn) The method of claim 2 wherein said tricyclic antidepressant compound is selected from the group consisting of doxepin, amitriptyline, desipramine, imipramine and physiologically acceptable acid addition salts thereof.

4. (Withdrawn and Currently Amended) The method of claim 3 wherein said physiologically acceptable acid addition salts are selected from the group consisting of the hydrochloride, hydrobromide, hydroiodide, acetate, valerate andoleate.

5. (Withdrawn) The method of claim 1 wherein said non-narcotic analgesic is administered in a dosage from about 0.50 gms to about 2.6 gms daily.

6. (Withdrawn) The method of claim 1 wherein said non-narcotic analgesic is selected from the group consisting of acetaminophen and NSAIDs.

7. (Withdrawn) The method of claim 2 wherein said low dose of tricyclic antidepressant compound and said standard dose of non-narcotic analgesic are present in a single composition including a pharmaceutically acceptable vehicle for oral administration.

8. (Withdrawn) The method of claim 7 wherein said composition is in a form selected from the group consisting of tablets, capsules, caplets, oral solutions, and oral suspensions.

9. (Previously Presented) A composition for treatment of chronic pain consisting essentially of a combination of a low dose of a tricyclic antidepressant compound, said dose in the range 2.5-25 mg, and a standard dose of a non-narcotic analgesic in a single pharmaceutically acceptable vehicle for oral administration.

10. (Cancelled)

11. (Previously Presented) The composition of claim 9 wherein said tricyclic antidepressant compound is selected from the group of tricyclic compounds consisting of doxepin, amitriptyline, desipramine, imipramine, and physiologically acceptable acid addition salts thereof.

12. (Previously Presented) The composition of claim 11 wherein said physiologically acceptable acid addition salts are selected from the group consisting of the hydrochloride, hydrobromide, hydroiodide, acetate, valerate and oleate.

13. (Cancelled)

14. (Previously Presented) The composition of claim 9 wherein said non-narcotic analgesic is selected from the group consisting of acetaminophen and non-steroidal anti-inflammatory drugs.

15. (Previously Presented) The composition of claim 9 wherein the combination of a tricyclic antidepressant and a non-narcotic analgesic and a pharmaceutically acceptable vehicle is in a form selected from the group consisting of tablets, capsules, caplets, oral solutions and oral suspensions.

16. (Cancelled)

17. (Previously Presented) The composition of claim 9 wherein said non-narcotic analgesic is administered in a dosage of from about 0.5 gm to about 2.6 gm daily.

Evidence Appendix

Related Proceedings Appendix

None.